



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,038	12/15/2003	Eric David Harper	20503-4023	4020
34313	7590	04/28/2010	EXAMINER	
ORRICK, HERRINGTON & SUTCLIFFE, LLP			DEGA, MURALI K	
IP PROSECUTION DEPARTMENT				
4 PARK PLAZA			ART UNIT	PAPER NUMBER
SUITE 1600				
IRVINE, CA 92614-2558			3621	
			MAIL DATE	DELIVERY MODE
			04/28/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/736,038	HARPER ET AL.	
	Examiner	Art Unit	
	MURALI DEGA	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 January 2010.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Acknowledgements

1. This Office action is in response to amendment filed on 21 January, 2010, in reply to the previous Office action mailed on 21 July, 2009.
2. Claims 1-25 are pending (“pending claims”).
3. Claims 1-25 have been examined (“examined claims”).
4. This office action has been assigned Paper No. 20100423. Paper No. is for reference purposes only.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- a. “a first subset of the plurality of license rights” in line 16 of claim 1;
- b. “a second subset of license rights” in line 18 of claim 1;
- c. “the first subset of the plurality of license rights” in line 19 of claim 1;
- d. “the second subset of license rights” in line 20 of claim 1;
- e. “a first subset of the plurality of license rights” in line 20 of claim 11;
- f. “the first subset of the plurality of license rights” in lines 21 and 24 of claim 11;
- g. “a second subset of license rights” in line 22 of claim 11;

- h. "the second subset of license rights" in line 24 of claim 11;
- i. "a first subset of the plurality of license rights" in claims 21 and 23;
- j. "a second subset of license rights" in claims 21 and 23;
- k. "the first subset of the plurality of license rights" in claims 21 and 23;
- l. "the second subset of license rights" in claims 21 and 23;

Claim objection

- 6. Claim 21 recites "in response to a reply from the server update the license file with information concerning the availability of the license" which appears to have been intended to be -- in response to a reply from the server, update the license file with information concerning the availability of the license—
- 7. Appropriate correction or clarification is requested.

Claim Rejections - 35 USC § 101

- 8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
- 9. Claim 11-20 are alternatively rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. This is an alternative rejection only.
 - m. Claim 11 recites a computer program only. "Computer programs claimed as separately testable systems or utilities *per se*, i.e., the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed." MPEP §2106.01 I. Because the claims

recite only abstractions that are neither “things” nor “acts,” the claims are not within one of the four statutory classes of invention. The Examiner notes that using the broadest reasonable interpretation of “system” as noted below, the claimed “system” is interpreted as software only. Because the broadest reasonable interpretation of “system” includes software *per se*, the claims are not within one of the four statutory classes of invention and are therefore rejected under 35 U.S.C. § 101.

10. Alternatively, claim 11 is also rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because it is a hybrid claim. See MPEP §2173.05(p) II. and the 112 2nd paragraph rejection below.

Claim Rejections - 35 USC § 112 - 2nd Paragraph

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
12. Claims 11-21 and 24 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
13. Claim 11 is indefinite because the claim is considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claim is directed to neither a “process” nor a “machine” but rather embrace or overlap different statutory classes of invention as set forth in 35 U.S.C. §101.
14. For example the claim recites “[a] system”. In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicants to claim a machine claim. Alternatively, these claims recite “a license store” for storing information

concerning a license, “a software identification store” for storing identification information relating to the given software application, “a computer identification store” for storing identification information and “a transaction arrangement”. It is not clear to one of ordinary skill in the art if the Applicants are claiming a general computer or a plurality of computers in a physical store where copy of the given software application, a license store for storing a physical license, a software identification store where the physical identification information is stored and a computer identification store to store physical identification numbers of the plurality of computers. In light of this conflicting evidence, a person of ordinary skill in the art can not reasonably interpret the statutory class of the invention as recited in claim 11.

15. Claim 11 recites “to verify whether the given software application is available for use by the first computer of the plurality of computers and to transmit to the one computer the license, having plurality of license rights,” The claim is indefinite because it is not clear to one of ordinary skill in the art, a) if the license being transmitted to the first computer or to some other computer named “the one computer”.

16. Claim 24 recites “the first computer selecting license rights to be applied to the one computer and transmitting details of the selected rights to the first computer”. The claim is indefinite because it is not clear to one of ordinary skill in the art, a) if the first computer selecting the rights or just making the request, b) if the “one computer” is the “first computer” or a different computer other than the “first computer” and c) if the “transmitting details of the selected rights” is to the “one computer” or from the “one computer”.

17. Claim 24 recites the limitation "one computer" in line 5. There is insufficient antecedent basis for this limitation in the claim.

18. The Examiner finds that because the claims noted above are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Misra et al. (US 6,189,146), in view of Irwin et al. (US 2005/0071280) further in view of Bergler et al. (US 7,343,297), herein after referred to as Bergler.

21. With regards to **claim 1**:

22. Misra discloses a system comprising:

- n. a plurality of computers (intermediate servers 32(1), 32(2)), each computer of the plurality of computers capable of running (“applications run
- o. at the server”, C 5, ll. 21-22) a given software application (Software product),

- p. a server having a server store (License server 28, Fig. 1),
- q. communication channels respectively permitting communication between each computer of the plurality of computers and the server (Network 92, Fig. 2),
- r. a transaction arrangement operable respectively between each computer of the plurality of the computers (Clients 30, Servers 32) and the server via the communication channels (Network 92, Fig. 2) for enabling a predetermined use of the given software application by each computer (“use of software”, C 1, line 59) of the plurality of computers (“The client 30 then uses the license to gain access to the resources provided by the intermediate server 32”, C 6, ll. 28-30),
- s. wherein the server (Server 28) controls the predetermined use of the given software application by a first computer (Server 32(1)) of the plurality of computers according to conditions stored in the server store (“database record kept at the license server”, Abstract, C. 3, ll. 20-21), wherein the given software application and the first computer are identifiable by the server using a license, the license having a plurality of license rights, and wherein a first subset of the plurality of license rights is available under the license to the first computer of the plurality of computers, and wherein a second subset of license rights is available under the license to a second computer of the plurality of computers, and wherein the license the first subset of the plurality of license fights, and the second subset of the plurality of license rights are voluntarily returnable by the first and second computers to the server for use by another computer of the plurality of computers.

- t. Misra discloses license pack containing a set of one or more individual software licenses but does not disclose set or sub set of license rights.
- u. However, Irwin teaches rightsholder selling or license all rights or subset of rights (“license those rights or subset of rights”, ¶ [0007]).
- v. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have combined the method of Misra, with the teachings of Irwin, to include divide the rights into subsets, to provide access to various functions of the application to several users enabling the use of the same license, to make use of the single license more efficiently across the plurality of computers, with neither undue experimentation, nor risk of unexpected results.
- w. Misra does not explicitly disclose licenses being returned by the computer to the server. However, Bergler teaches licenses being returned (Abstract, “automatically returned to the license server’s available pool”, ¶ [0025]) to the license pool as part of license management by the server to assure the license availability to other computers in the network.
- x. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Misra, so as to have included the step of returning the license that is not required by the computer, to the server, in accordance with Bergler, to ensure availability of licenses to other computers and thus reducing the cost of multiple licenses through usage optimization by returning the license by the one computer if he license is not being used, with neither undue experimentation, nor risk of unexpected results.

23. With respect to **claim 2**:

24. Misra discloses wherein the transaction arrangement determining access of each computer of the plurality of computers to the given software application (Fig. 1, col. 6, ll. 21-30 and col. 8, ll.60-67, a license server distributing licenses and the client using the license to gain access to other applications is provided).

25. With respect to **claim 3**:

26. Misra discloses wherein the transaction arrangement determining parameters of operation for the given software application (Abstract, col. 2, ll.62-76, col. 3, ll.8-15 and col. 4, ll.49-58, in which an automatic mechanism for obtaining license, license server determining the appropriate type of license for the client and the license server checking the client status is described).

27. With respect to **claim 4**:

28. Misra discloses wherein the server controlling the number of the plurality of computers authorized to run the given software application (Fig. 3, col. 7, table 1 and col. 10, ll. 51-59, where in the server keeps track of clients receiving licenses).

29. With respect **claim 5**:

30. Misra discloses wherein the software application comprises a computer program operable under the license, and wherein the transaction arrangement comprises a license management system for verifying the availability for each computer of the plurality of computers of the license for the computer program (Fig. 3, col. 8, ll. 35-52 and col.12, ll. 8-27, the license management system is described).

31. With respect to **claim 6**:

32. Misra discloses wherein the license management system controls license rights available under the license, and configures each computer of the plurality of computers to operate according to the license rights (Abstract, col. 3, ll. 8-15, col. 10, ll. 30-37 and col. 10, ll. 45-50 , a rights management and a system to configure clients operating system is provided).

33. With respect to **claim 7**:

34. Misra discloses wherein the license management system stores therein different possible license rights available under the license, selects a license right of the license rights from the server store, and activates the license right for each compute of the plurality of computers (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

35. With respect to **claim 8**:

36. Misra discloses wherein the each computer of the plurality of computers stores details of the license rights and updates details on use of the computer program (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

37. With respect to **claim 9**:

38. Misra discloses wherein the license management system transfers the license from one computer of the plurality of computers to another computer of the plurality of computers (Abstract, fig. 3, col. 11, ll. 36-45 and col. 2, ll32-47, a regular communication between clients and license server being facilitated).

39. With respect to **claim 10**:

40. Misra discloses wherein the license management system inhibits operation of the computer program on the one computer following the transfer (Abstract, fig. 3, col. 11, ll. 36-45, col. 2, ll. 32-47 and col. 3, ll. 16-26, a method to prevent unauthorized usage is provided).

41. With respect to **claim 11**:

42. Misra discloses a system comprising:

y. an application store associated with each computer of the plurality of computers for storing a copy of the given software application (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

z. a license store for storing information concerning a license to operate the given software application, wherein the given software application comprises a computer program operable under the license (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

aa. a software identification store for storing identification information relating the given software application (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

bb. a computer identification store for storing identification information relating to each computer of the plurality of computers (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

cc. a transaction arrangement operatively linking the application store, the license store, the software identification store and the computer identification store, the transaction arrangement being responsive to a request from a one computer of the

plurality of computers for use of the given software application to verify whether the given software application is available for use the one computer of the plurality of computers and to transmit to the one computer the license, having a plurality of license rights, to use the given software application in the event that the given software application is so available wherein a first subset of the plurality of license rights is available under the license to the first computer of the plurality of computers, and wherein a second subset of license rights is available under the license to a second computer of the plurality of computers, and wherein the license the first subset of the plurality of license rights, and the second subset of the plurality of license rights are returnable by the first and second computers to the server for use by another computer of the plurality of computers (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

dd. Misra discloses license pack containing a set of one or more individual software licenses but does not disclose set or sub set of license rights.

ee. However, Irwin teaches rightsholder selling or license all rights or subset of rights (“license those rights or subset of rights”, ¶ [0007]).

ff. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have combined the method of Misra, with the teachings of Irwin, to include divide the rights into subsets, to provide access to various functions of the application to several users enabling the use of the same license, to make use of the single license more efficiently across the plurality of computers, with neither undue experimentation, nor risk of unexpected results.

gg. Misra does not explicitly disclose licenses being returned by the computer to the server. However, Bergler teaches licenses being returned (Abstract, “automatically returned to the license server’s available pool”, ¶ [0025]) to the license pool as part of license management by the server to assure the license availability to other computers in the network.

hh. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Misra, so as to have included the step of returning the license that is not required by the computer, to the server, in accordance with Bergler, to ensure availability of licenses to other computers and thus reducing the cost of multiple licenses through usage optimization by returning the license by the one computer if he license is not being used, with neither undue experimentation, nor risk of unexpected results.

43. Claim 11 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Misra, Irwin and Bergler as described above and further in view of Fig. 2, 40 of Misra.

44. It is the Examiner’s principle position that the claim 11 is rendered obvious as noted above because a computer as depicted in Fig. 2 of Misra, consists of storage capabilities to store copy of software application, store license information, store software application information, store computer identification information and can operatively link all the information stored on the computer, as linked by the System Bus.

45. With respect to **claim 12**:

46. Misra discloses a server providing the license store, the software identification store and the computer identification store (Abstract and fig. 3, where a server that stores license information is described).

47. With respect to **claim 13**:

48. Misra discloses wherein the server controls the number of licenses available for the given software application (Fig. 3, col. 7, table 1 and col. 10, ll. 51-59, where in the server keeps track of clients receiving licenses).

49. With respect to **claim 14**:

50. Misra discloses wherein server transfers a license from one computer of the plurality of computers to another computer of the plurality of computers (Abstract, figs. 3 and 4)

51. With respect to **claim 15**:

52. Misra discloses wherein the server inhibits operation of the computer program on the one computer following the transfer (Abstract, fig. 3, col. 11, ll. 36-45, col. 2, ll32-47 and col. 3, ll. 16-26, a method to prevent unauthorized usage is provided).

53. With respect to **claim 16**:

54. Misra discloses further comprising a license store provided at each computer of the plurality of computers for storing locally information concerning the license (Abstract and col. 3, ll. 22-25).

55. With respect to **claim 17**:

56. Misra discloses parameters of operation for the given software application (Abstract, col. 2, ll.62-76, col. 3, ll.8-15 and col. 4, ll.49-58, in which an automatic mechanism for obtaining

license, license server determining the appropriate type of license for the client and the license server checking the client status is described).

57. With respect to **claim 18**:

58. Misra discloses wherein the transaction arrangement verifies license rights available under the license (Fig. 3 and 5, col. 8, ll. 35-52, col.12, ll. 8-27, col. 13, ll. 65-67 and col. 14, ll. 1-21, the license management system is described).

59. With respect to **claim 19**:

60. Misra discloses license store having a data store for storing therein different possible license rights available under the license, and wherein the transaction arrangement selects a license right of the license rights and activates the license right for each computer of the plurality of computers (Abstract, fig. 3 and 4, col. 8, ll. 35-67 and col.12, ll. 8-27, the license management system is described along with selection and activation of the said licenses).

61. With respect to **claim 20**:

62. Misra discloses wherein each computer of the plurality of computers stores details of the license right, and updates the license rights according to the current state of the license right on use of the computer program (Abstract, fig. 3 and 4, col. 8, ll. 35-67 and col.12, ll. 8-27, the license management system is described along with selection and activation of the said licenses).

63. With respect to **claim 21**:

64. Misra discloses a computer readable medium having stored thereon a plurality of instructions, the plurality of instructions, when executed by a processor, cause the processor to:

- ii. create a license file for a license to operate the given software application, wherein the license is returnable by one computer of the plurality of computers the create

a license file for a license to operate the given software application, the license having a plurality of license rights, and wherein a first subset of the plurality of license rights is available under the license to a first computer of the plurality of computers, and wherein a second subset of license rights is available under the license to a second computer of the plurality of computers, and wherein the license, the first subset of the plurality of license rights, and the second subset of the plurality of license rights are voluntarily returnable by the first and second computers to the server for use by another computer of the plurality of computers (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

jj. Misra discloses license pack containing a set of one or more individual software licenses but does not disclose set or sub set of license rights.

kk. However, Irwin teaches rightsholder selling or license all rights or subset of rights (“license those rights or subset of rights”, ¶ [0007]).

ll. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have combined the method of Misra, with the teachings of Irwin, to include divide the rights into subsets, to provide access to various functions of the application to several users enabling the use of the same license, to make use of the single license more efficiently across the plurality of computers, with neither undue experimentation, nor risk of unexpected results.

mm. Misra does not explicitly disclose licenses being returned by the computer to the server. However, Bergler teaches licenses being returned (Abstract, “automatically returned to the license server’s available pool”, ¶ [0025]) to the license pool as part of

license management by the server to assure the license availability to other computers in the network.

nn. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Misra, so as to have included the step of returning the license that is not required by the computer, to the server, in accordance with Bergler, to ensure availability of licenses to other computers and thus reducing the cost of multiple licenses through usage optimization by returning the license by the one computer if he license is not being used, with neither undue experimentation, nor risk of unexpected results.

oo. Assign to the license file a serial number representing the given software application (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

pp. Assign to the license file an identification code representing the computer (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

qq. Transmit to a server a request to execute the given software application (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

rr. The request including the serial number and the identification code; in response to a reply from the server, update the license file with information concerning the availability of the license; and read the license file for establishing whether the given software application can be executed (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47

and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

65. With respect to **claim 22**:

66. Misra discloses having additional instructions stored thereon, the additional instructions, when executed by the processor, causing the processor to further: in response to reply from the server updating the license file with details of license rights transmitted from the server; and configure the computer according to the license rights to execute a predetermined software feature incorporated in the given software application (Abstract and col. 11, ll. 25-45, a license granting process is described).

67. With respect to **claim 23**:

68. Misra discloses a computer implemented method comprising:

ss. Creating a license file on a first computer of the plurality of computers for a license to operate the given software application the license having a plurality of license rights, and wherein a first subset of the plurality of license rights is available under the license to the first computer of the plurality of computers, and wherein a second subset of license rights is available under the license to a second computer of the plurality of computers, and wherein the license, the first subset of the plurality of license rights, and the second subset of the plurality of license rights are returnable by the first and second computers to the server for use by another computer of the plurality of computers (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

- tt. Misra discloses license pack containing a set of one or more individual software licenses but does not disclose set or sub set of license rights.
- uu. However, Irwin teaches rightsholder selling or license all rights or subset of rights (“license those rights or subset of rights”, ¶ [0007]).
- vv. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have combined the method of Misra, with the teachings of Irwin, to include divide the rights into subsets, to provide access to various functions of the application to several users enabling the use of the same license, to make use of the single license more efficiently across the plurality of computers, with neither undue experimentation, nor risk of unexpected results.
- ww. Misra does not explicitly disclose licenses being returned by the computer to the server. However, Bergler teaches licenses being returned (Abstract, “automatically returned to the license server’s available pool”, ¶ [0025]) to the license pool as part of license management by the server to assure the license availability to other computers in the network.
- xx. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Misra, so as to have included the step of returning the license that is not required by the computer, to the server, in accordance with Bergler, to ensure availability of licenses to other computers and thus reducing the cost of multiple licenses through usage optimization by returning the license by the one computer if he license is not being used, with neither undue experimentation, nor risk of unexpected results.

yy. License assigning to the license file an identification code representing the one computer (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

zz. Formulating a request to execute the given software application at the first computer, the request including a serial number associated with the given software application and an identification code of the first computer (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

aaa. Transmitting the request with the serial number and the identification code to the server; in response to a reply from the server updating the license file with information concerning the availability of the license; and reading the license file for establishing the status of the license at the one computer (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

69. With respect to **claim 24**:

70. Misra discloses storing at the server information concerning license rights available under the license; in response to the request from the first computer selecting license rights to be applied to the one computer and transmitting details of the selected rights to the first computer; in response to the reply from the server updating the license file with details of the selected license rights transmitted from the server; and configuring the first computer according to the selected license rights to execute a predetermined software feature incorporated in the given

software application (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

71. With respect to **claim 25**:

72. Misra discloses updating the license file on an ongoing basis during use of the predetermined feature by the first computer to record a current state of the license; and when the license is no longer required transmitting details from the updated license file of the current state to the server (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

Claim Interpretation

73. The Examiner finds that because the examined claims recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because all examined claims (*i.e.* claims 1-25) fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

74. After careful review of the original specification, the Examiner finds that he can not locate any lexicographic definitions (either express lexicographic definitions or implied lexicographic definitions) with the required clarity, deliberateness, and precision. Because the Examiner can not located any lexicographic definitions with the required clarity, deliberateness, and precision, the Examiner concludes that Applicants are not their own lexicographer. See MPEP §2111.01 IV.

75. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

bbb. **For:** "1 a -- used as a function word to indicate purpose... b -- used as a function word to indicate an intended goal" Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

ccc. **System:** (n) system (a procedure or process for obtaining an objective) "they had to devise a system that did not depend on cooperation". WordNet: An Electronic Lexical Database, May 1998. ISBN-10: 0-262-06197-X and ISBN-13: 978-0-262-06197-1

ddd. **Computer:** "Any machine that does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output." Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

eee. **Configure:** "to set up for operation esp. in a particular way." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A. 1986.

fff. **Perform:** To Carry out; execute. 2. To go through. The Random House College Dictionary. Revised Edition 1982.

ggg. **To:** "2a -- used as a function word to indicate purpose, intention, tendency, result, or end." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

hhh. **Code:** “n. 1. Program instructions. Vb. 2. To write program instructions in a programming language. Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 2002.

iii. **Server:** “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

jjj. **Using:** The act of employing using or putting into service. The Random House College Dictionary. Revised Edition 1982.

kkk. **Application:** “A program designed to assist in the performance of a specific task, such as word processing, accounting, or inventory management. *Compare* utility.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

lll. **Associate:** “4 : to bring together or into relationship in any of various intangible ways (as in memory or imagination).” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

mmm. **Can:** “1...f : be inherently able or designed to.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

nnn. **Information** “ 2 a . . . (3): FACTS, DATA . . . ” Merriam-Webster's Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

ooo. **Verify:** “2 : to establish the truth, accuracy, or reality of.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

ppp. **When:** “2 : in the event that: IF.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

qqq. **Permitting:** 1. to consent to expressly or formally; 2. to give leave : Authorize 3. to make possible Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A. 1986.

rrr. **Arrangement:** 1 a: the state of being arranged b: the act of arranged. Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield, M.A. 1986.

76. With respect to claims 1-20, the Examiner notes the following: "A 'system' is an 'apparatus.'" *Ex parte Fressola*, 27 USPQ2d 1608, 1611 (B.P.A.I. 1993) citing *In re Walter*, 618 F.2d 758, 762 n.2, 205 USPQ 397, 402 n.2 (CCPA 1980). Additionally, "[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore for purposes of applying the prior art only, it is the Examiner's position that Applicants' system claims (*i.e.* claims 1-20) are "product," "apparatus," or more specifically, "machine" claims.

Response to Arguments

77. Applicants' arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

78. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

79. Applicants' amendment filed January 21, 2010 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

80. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

81. Applicants are respectfully reminded that any suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. To be especially clear, any suggestion or example provided in this Office Action (or in any future office action) does not constitute a formal requirement mandated by the Examiner.

sss. Should Applicants decide to amend the claims, Applicants are also reminded that—like always—no new matter is allowed. The Examiner therefore leaves it up to Applicants to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112 1st paragraph.

ttt. Independent of the requirements under 35 U.S.C. § 112 1st paragraph, Applicants are also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicants amend the claims such that the claim language no longer has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these rare situations where the amended claim language does not have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicants are encouraged to either (1) re-evaluate the amendment and change the claim language so the claims do have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicants choose to amend the specification, Applicants are reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicants have any questions on this matter, Applicants are encouraged to contact the Examiner via the telephone number listed below.

82. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to MURALI DEGA whose telephone number is (571)270-5394. The Examiner can normally be reached on Monday to Thursday 7.00AM to 5.30 PM.

83. If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

84. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Murali K. Dega/
Art Unit 3621
April 24, 2010

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621